

PATENT
Atty. Dkt. No. ROC820010002US1
MPS Ref. No.: IBM/K10002

REMARKS

This is intended as a full and complete response to the Office Action dated April 8, 2005, having a shortened statutory period for response set to expire on July 8, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1, 4-21, 24 and 27-38 are pending in the application. Claims 1, 4-21, 24 and 27-38 remain pending following entry of this response. Claims 1, 16-21 and 24 have been amended. Claims 39-44 have been added to recite aspects of the invention. Applicants submit that the amendments and the new claims do not introduce new matter.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 4-9, 11-13, 15, 16-17, 19-21, 24, 27-32, 34-36 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by *Quinlan et al.* (US Patent 6, 748, 365B1, hereinafter "*Quinlan*"). Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Quinlan* does not disclose "each and every element as set forth in the claim". For example, *Quinlan* does not disclose a single entity (e.g., the rebate server computer) that performs all of the steps as claimed. *Quinlan* discloses a point-of-sale data processing and storage system 210 for processing purchases and identifying each qualified transactions with a serial number (*Quinlan* col. 17, lns. 30-34) and a "fulfillment administrator" having a processor 270 for processing the rebate (*Quinlan* col. 17, ln. 65 to col. 18, ln. 18). The "fulfillment administrator" does not provide purchase identifiers to the point-of-sale system but rather receives an electronic file from the point-of-sale system. In contrast, in the invention as claimed, the purchase identifier is provided by the rebate computer system in response to a request from a store computer

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system, as recited in the independent claims. Furthermore, *Quinlan* does not disclose that the purchase identifier is verified by the same rebate computer system from which the purchase identifier originated.

The Examiner has stated again that the steps recited in the claims regarding "... the further step of generating and transmitting a purchase identifier to the store computer, upon receiving a request for the purchase identifier, does not directly impact the process of completing a rebate claim, verifying the purchase identifier related to the rebate claim and accepting the rebate claim." Applicant re-asserts that a single entity (i.e., a rebate server system) providing the purchase identifier facilitates the rebate process and does "impact" the rebate process by, for example, reducing or eliminating errors that may occur due to transmission between the point-of-sale system and the rebate processing system or detecting fraudulent submissions. Furthermore, the step of verifying the received information includes a determination as to whether the received information includes a match to the purchase identifier previously generated by the rebate server computer system. Such verification step cannot occur in a system in which the purchase identifier is not generated by the rebate processing system.

The Examiner further states that these steps are "silently or implicitly supported by *Quinlan*" and that these features are inherent in the art or widely used in the industry. Applicants submit that the features described by the Examiner regarding a typical store computer sales system which issues a "transaction serial number" still does not disclose that a rebate server system, which is a different entity from the store computer sales system, perform the steps of generating and transmitting a purchase identifier to the store computer, upon receiving a request for the purchase identifier, and subsequently verifying the received information to determine whether the received information includes a match to the purchase identifier previously generated by the rebate server computer system. The claims have been amended to more clearly recite that the rebate server system performs these steps.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

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Claim Rejections - 35 U.S.C. § 103

Claims 14, 18 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Quinlan*. However, Applicants believe that rejections based on *Quinlan* have been overcome for reasons given above. Accordingly, the claims are believed to be allowable and allowance of the same is respectfully requested.

Claims 10 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Quinlan* in view of *Lemon*, US Patent 4,674,041. However, Applicants believe that rejections based on *Quinlan* have been overcome for reasons given above. Accordingly, the claims are believed to be allowable and allowance of the same is respectfully requested.

Conclusion

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,


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